



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/998,302	12/24/97	STANFIELD J	STE01-P798B

LM01/0831  
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EXAMINER
ZIMMERMAN, B

ART UNIT	PAPER NUMBER
2735	


DATE MAILED: 08/31/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No. <b>08/998,302</b>	Applicant(s) <b>Stanfield</b>
Examiner <b>Brian Zimmerman</b>	Group Art Unit <b>2735</b>



☒ Responsive to communication(s) filed on Jul 6, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1, 12, 13, 19, 23, 34-38, and 54 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 12, 13, 19, 23, 34-38, and 54 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **EXAMINER'S RESPONSE**

#### **Status of Application.**

1. In response to the applicant's election and amendment received on 7/6/98. The examiner has considered the new presentation of claims and applicant arguments in  
5 view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 1,12,13,19,23,34-38,54 are unpatentable for the reasons set forth in this office action:

### **INFORMALITIES**

10 2. Applicant's election with traverse of Group VII (claims 1,12,13,19,23,34-38,54) is acknowledged.

The restriction requirement is upheld for at the least the following. Examples of distinctness between the subcombinations have been shown in paragraph #2 Office  
Action 6/8/98. Merely because all the claimed species can be operate in the same  
15 system is not evidence that the species are not mutually exclusive.

3. This application contains claims drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### CLAIMS

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10 A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

15 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1,12,13,19,23,34,54 are rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 5751221 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a file tracking system including a folder (file) with conductors to communicate to the folder.

25 Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

**ART REJECTION**

6. Claims 1,12,13,19,23,34,54 are rejected under 35 U.S.C. § 103 as being unpatentable over Smith 5455409 and Kott 4376936 and Foster 5287414.

Smith shows a file tracking system in which a processor is connected to a bus  
5 which is connected to a folder retainer 12. the processor sends information to a folder such that a indicator displays the location of the folder to a user requesting to know the location of the folder. Smith discloses that the use of a data base to maintain the location information is an alternative to the distributed database system. The examiner takes official notice that the use of a personal computer or computers on a LAN are  
10 common processor system available to the artisan.

In an analogous art, Kott shows a filed folder which is addressed by a conductive bus. The folder includes an address, a comparator and a light indicator to assist the user in locating the file. The examiner takes official notice that the use of a transistor to operate a light indicator in the manner claimed is verily common in the art,  
15 to isolate the lamp/light from the switch. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the folder of Kott to store documents in a filing system which can locate the folders in the manner suggested by Smith.

In an analogous art, Foster shows multiple addressable cabinets can be used to  
20 store folders. The cabinets include indicators to tell the user which cabinet houses the folder which the user is trying to locate. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to have utilized multiple addressable cabinets, each with an addressable indicator to assist the user in locating a folder in the above modified system.

- 5     7.     Claims 35-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **REMARKS**

10     Response to Arguments.

The following discussion is introduced in direct response to the arguments presented in the instant amendment:

It is pointed out that Smith does in fact disclose the use of a central database in a file retrieval system, however Smith chooses not to utilize such a database. See  
15     abstract. From this suggestion, the skilled artisan would reliably be able to efficiently update and manage a database of information.

It is pointed out that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary  
20     skill in the pertinent art.

Kott does show a device which is responsive to being addressed, and Smith

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shows a signal being sent to the central database for maintenance of an up to date  
location database (see col. 3 lines 5-40).

**CONTACT INFORMATION**

5                   Any inquiry concerning this communication or earlier communications  
from the examiner should be directed to Brian Zimmerman whose telephone number is  
(703) 305-4796.

Any inquiry of a general nature or relating to the status of this application should  
be directed to the Group receptionist whose telephone number is (703) 305-3900.

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**Brian Zimmerman  
Patent Examiner  
Art Unit 2735**

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703-305-4796  
August 25, 1998